APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,675	02/15/2002	Thomas C. Shaw	POU901038US2	2840

46369 7590 01/12/2005		EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203		DUNCAN, MARC M	

ART UNIT	PAPER NUMBER
2113	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Offic Action Summary	10/076,675	SHAW, THOMAS C.
	Examin r	Art Unit
	Marc M Duncan	2113

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*15 February 2002*</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-20 and 22-37* is/are rejected.

7)☒ Claim(s) *8 and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/2/02*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Status of the Claims

Claims 29-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3, 5-7, 9, 14-16, 28-20, 22, 23, 29-31, 33-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Bressoud et al.

Claims 1-6, 9, 14-19, 22, 23, 29-34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Casella et al.

Claims 8 and 21 are objected to.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer is a machine, but a machine is not necessarily a computer. Programs of instructions must have a functional interrelationship defined with a computer to be considered statutory. See MPEP 2106.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to th date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 9, 14-16, 28-20, 22, 23, 29-31, 33-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Bressoud et al.

Regarding claim 1:

Bressoud teaches controlling an event around system processing thereof in the Abstract lines 6-10 and col. 2 lines 51-54.

Bressoud teaches wherein the controlling comprises facilitating intercepting of the event by a test tool after processing thereof by the system and before return to an internal system invoker of the system event processing, the invoker being other than the test tool in the Abstract lines 6-10 and col. 2 lines 51-54. The replica supervisor of Bressoud is equivalent to a test tool as claimed by applicant because the replica supervisor performs all functions of the test tool as claimed. Further, the replica supervisor does not invoke the system event, it merely intercepts and controls it.

Regarding claim 2:

Bressoud teaches wherein the controlling further comprises facilitating intercepting of the event by the test tool both before and after processing thereof by the system in the Abstract lines 6-10 and col. 2 lines 51-54. The replica supervisor intercepts both the calls to the operating system to process the event and the results that are being returned after the event is processed.

Regarding claim 3:

Bressoud teaches wherein the event comprises an intercepted event within the system in the Abstract lines 6-10 and col. 2 lines 51-54. The event is intercepted and is therefore an intercepted event.

Regarding claim 5:

Bressoud teaches wherein the intercepting by the test tool facilitates validation of system processing of the event in col. 2 lines 44-47 and col. 3 lines 20-29.

Regarding claim 6:

Bressoud teaches wherein the event comprises a system managed event in col. 3 lines 20-29. The event is being managed by the system and therefore meets the broadest reasonable interpretation of applicant's claimed system managed event.

Regarding claim 7:

Bressoud teaches wherein the controlling further comprises allowing an indication prior to system processing of the event whether control is to pass to the test tool after processing thereof in col. 3 lines 20-29. This function is inherent to the teachings of Bressoud. Control is returned to the replica supervisor after processing of the event and therefore allowing an indication that control is to return to the replica supervisor is necessarily present.

Regarding claim 9:

Bressoud teaches wherein the event is an internal system event having no external system call in col. 3 lines 20-29. The call to the operating system is not an external system call.

Regarding claim 14:

The claim is rejected as the means for performing the method of claim 1.

Regarding claim 15:

The claim is rejected as the means for performing the method of claim 2.

Regarding claim 16:

The claim is rejected as the means for performing the method of claim 3.

Regarding claim 18:

The claim is rejected as the means for performing the method of claim 5.

Regarding claim 19:

The claim is rejected as the means for performing the method of claim 6.

Regarding claim 20:

The claim is rejected as the means for performing the method of claim 7.

Regarding claim 22:

The claim is rejected as the means for performing the method of claim 9.

Regarding claim 23:

The claim is rejected as the computing unit performing the method of claim 1.

Regarding claim 29:

The claim is rejected as the program product containing instructions causing the method of claim 1 to be performed.

Regarding claim 30:

The claim is rejected as the program product containing instructions causing the method of claim 2 to be performed.

Regarding claim 31:

The claim is rejected as the program product containing instructions causing the method of claim 3 to be performed.

Regarding claim 33:

The claim is rejected as the program product containing instructions causing the method of claim 5 to be performed.

Regarding claim 34:

The claim is rejected as the program product containing instructions causing the method of claim 6 to be performed.

Regarding claim 35:

The claim is rejected as the program product containing instructions causing the method of claim 7 to be performed.

Regarding claim 37:

The claim is rejected as the program product containing instructions causing the method of claim 9 to be performed.

Claims 1-6, 9, 14-19, 22, 23, 29-34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Casella et al.

Regarding claim 1:

Casella teaches controlling an event around system processing thereof in the Abstract lines 3-5.

Casella teaches wherein the controlling comprises facilitating intercepting of the event by a test tool after processing thereof by the system and before return to an

internal system invoker of the system event processing, the invoker being other than the test tool in the Abstract lines 3-5 and col. 2 lines 34-37. Capturing a response is capturing the event after is has been processed. The client and server are both contained with one system and therefore it is an internal system event that was invoked by the client and not by the test tool.

Regarding claim 2:

Casella teaches wherein the controlling further comprises facilitating intercepting of the event by the test tool both before and after processing thereof by the system in the Abstract lines 3-5. The test tool intercepts both requests and responses, which occur before and after event processing.

Regarding claim 3:

Casella teaches wherein the event comprises an intercepted event within the system in the Abstract lines 3-5. The event is intercepted and is therefore an intercepted event.

Regarding claim 4:

Casella teaches wherein the intercepting of the intercepted event by the test tool facilitates testing thereof in the Title and the Abstract lines 3-5. The intercepting entity is a testing and debugging tool and therefore clearly any action by the tool facilitates testing.

Regarding claim 5:

Casella teaches wherein the intercepting by the test tool facilitates validation of

system processing of the event in the Abstract lines 3-5. Anything the testing and

debugging tool intercepts would facilitate validation of system processing of the event.

Regarding claim 6:

Casella teaches wherein the event comprises a system managed event in col. 2

lines 34-37. The event is being managed by the system and therefore meets the

broadest reasonable interpretation of applicant's claimed system managed event.

Regarding claim 9:

Casella teaches wherein the event is an internal system event having no external

system call in col. 2 lines 34-37. The event takes place entirely within the system and

therefore has no external call.

Regarding claim 14:

The claim is rejected as the means for performing the method of claim 1.

Regarding claim 15:

The claim is rejected as the means for performing the method of claim 2.

Regarding claim 16:

The claim is rejected as the means for performing the method of claim 3.

Regarding claim 18:

The claim is rejected as the means for performing the method of claim 5.

Regarding claim 19:

The claim is rejected as the means for performing the method of claim 6.

Regarding claim 22:

The claim is rejected as the means for performing the method of claim 9.

Regarding claim 23:

The claim is rejected as the computing unit performing the method of claim 1.

Regarding claim 29:

The claim is rejected as the program product containing instructions causing the method of claim 1 to be performed.

Regarding claim 30:

The claim is rejected as the program product containing instructions causing the method of claim 2 to be performed.

Regarding claim 31:

The claim is rejected as the program product containing instructions causing the method of claim 3 to be performed.

Regarding claim 33:

The claim is rejected as the program product containing instructions causing the method of claim 5 to be performed.

Regarding claim 34:

The claim is rejected as the program product containing instructions causing the method of claim 6 to be performed.

Regarding claim 37:

The claim is rejected as the program product containing instructions causing the method of claim 9 to be performed.

Allowable Subject Matt r

Claims 8 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Prior art was not found that explicitly teaches or fairly suggests wherein the allowing the indication comprises setting a bit in a parameter list of the event indicating that control is to pass to the test tool after processing of the event by the system as outlined in claims 8 and 21. This limitation is considered allowable when the claims are read as a whole, including the base claims and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art not relied upon contains elements of the instant claims and/or represents a current state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc M Duncan whose telephone number is 571-272-3646. The examiner can normally be reached on M-T and TH-F 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

md

ROBERT BEAUSOLIEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100